

REMARKS

Claims 1-3 and 5-30 are currently pending in this application. By this amendment, Claim 4 has been canceled, Claims 1, 5, 7, 10, 11, 13, 14 and 21-24 have been amended and new Claims 27-30 have been added. No new matter has been added to this application by this amendment. In view of the amendments above and the remarks to follow, reconsideration and allowance of this application are respectfully requested.

In the Office Action, Claims 23 and 24 were rejected to under 37 C.F.R. § 1.75(c) as being of improper form because each recites "a method according to claim 15" and Claim 15 does not recite a method. Claims 23 and 24 have been amended to change their dependency from "15" to "21". Claim 21 recites "a method of performing a surgical procedure..." Applicants respectfully request that the rejection of Claims 23 and 24 under 37 C.F.R. § 1.75(c) be withdrawn.

Claim 22 has been amended to correct a typographical error in line 2. More specifically, "an circular" has been changed to --a circular--.

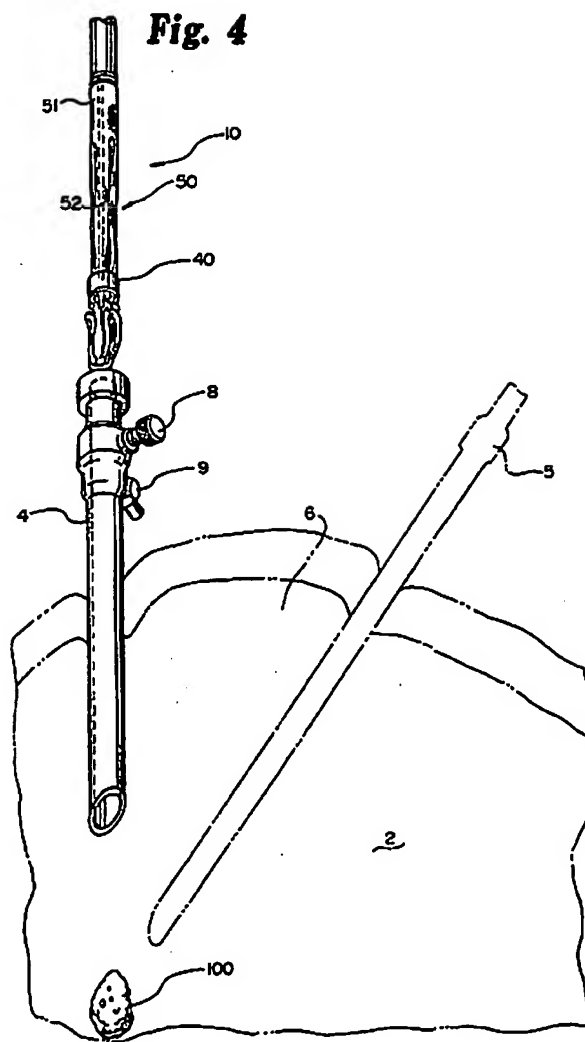
In the Office Action, Claims 7-20 were rejected under 35 U.S.C. § 112, second paragraph because the recitation "normally held" in line 3 of Claim 7 renders the claim indefinite. Claim 7 has been amended to change "normally held in abutment" to --urged into abutment-- to obviate any language which may be indefinite. Applicants submit that amended Claim 7 is definite.

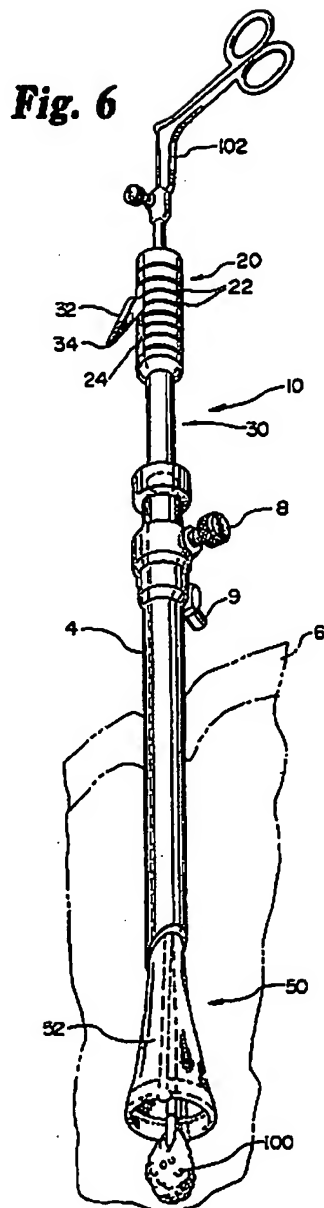
Claims 1-6, 21, 25 and 26 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,370,647 to Graber et al. ("Graber"). Under 35 U.S.C. § 102(b), "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of*

California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131.

Applicants respectfully submit that Graber fails to disclose each and every element, either expressly or inherently, recited in independent Claim 1. Claim 1, as amended recites a surgical instrument having a body portion, a tool member supported on the distal end of the body portion and an elongated cover supported about the body portion of the instrument. The elongated cover is formed from a collapsible material and has a substantially tubular configuration having open proximal and distal ends. The elongated cover is movable about the body portion of the instrument from a first position located proximally of the tool assembly to a second position at least partially encompassing the tool assembly. Claim 1 further recites that "when the elongated cover is in the first position the distal end of the elongated cover is secured to the instrument adjacent to the tool assembly such that the elongated cover can be inverted about the tool assembly as the elongated cover is moved from the first position to the second position."

Graber discloses a tissue and organ extractor 10 shown in FIGS. 4 and 6 reproduced below which includes a hollow handle 10, a hollow central shank 30, a ring 40 and an enveloping means 50. Hollow handle 10 and shank 30 are dimensioned to receive a forceps 102 (FIG. 6). Enveloping means 50 includes a neck 51 that is attached to the end of shank 30 and a flexible web 52 for enveloping tissue. A plurality of wires 39 extend from shank 30 to the open end of enveloping means 50. Ring 40 can be slid from neck 51 toward the open end of enveloping means 50 to collapse enveloping means 50. When extractor 10 is inserted through a cannula 4, ring 40 engages to top of cannula 40 and is moved proximally over enveloping means 50 and along shank 30 such that when enveloping means 50 emerges from cannula 4 enveloping means 50 flares outwardly to present an open area for insertion of tissue (FIG. 6).





Applicants respectfully submit that Graber does not disclose each and every element recited in Claim 1. More specifically, Graber does not disclose a surgical instrument which includes an elongated cover which has a distal end which is secured to the instrument adjacent to the tool assembly such that the elongated cover can be inverted about the tool assembly as

the elongated cover is moved from the first position to the second position such as recited in Claim 1. As discussed above, the proximal end of enveloping means 50 of Graber's extractor 10 is secured to the end of the shank 30. The distal end of Graber's enveloping means is not secured to the instrument adjacent a tool assembly as recited in Claim 1 such that the cover can be inverted about the tool assembly as also recited in Claim 1. For either of these reasons, Applicants submit that Graber does not anticipate Claim 1 and Claim 1 is in condition for allowance.

Claims 2-6 depend either directly or indirectly from Claim 1. For at least the reasons discussed above with respect to Claim 1, inter alia, Applicants believe that Claims 2-6 are also in condition for allowance.

Claim 26 recites a method according to Claim 25, wherein the closure device is a drawstring. As discussed above, Graber does not disclose an instrument which has a cover having a distal end secured about the instrument adjacent the tool assembly or a method of use which includes the step of moving the cover from the first position to the second position by inverting the cover at least partially over the tool assembly. For either of these reasons, Applicants believe that Claim 21 and Claims 25 and 26 which depend therefrom are not anticipated by Graber and are in condition for allowance.

Claims 7-20 and 22-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Garber in view of U.S. Publication No. 2004/0242960 to Orban ("Orban"). Orban was cited by the Examiner to allegedly show the "at least one expandable member". Claims 7-20 and Claims 22-25 depend from Claims 1 and 21, respectively. Orban does not cure the deficiencies of Graber with respect to Claims 1 and 26 as discussed above. Thus, for at least the reasons

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discussed above with respect to Claims 1 and 26, inter alia, Applicants believe that Claims 7-20 and 22-25 are also in condition for allowance.

New Claims 27-29 have been added to this application and are of a scope to which Applicants believe they are entitled. More specifically, Claims 27-29 are directed to a surgical stapler having the presently disclosed cover. Please note that original Claims 22 and 23 are directed to a surgical stapler.

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims pending in the application, namely claims 1-3 and 5-29, are in condition for allowance. Accordingly, early and favorable reconsideration of this application is respectfully requested. Should the Examiner feel that a telephone or personal interview may facilitate resolution of any remaining matters, he is respectfully requested to contact Applicant's attorney at the number indicated below.

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road - Suite 225
Melville, New York 11747
(631) 501-5700

Respectfully submitted,



Christopher G. Trainor
Reg. No. 39,517
Attorney for Applicant(s)

Correspondence Address:
Chief Patent Counsel
Covidien
60 Middletown Avenue
North Haven, CT 06473